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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,747	10/14/2003	Ronald L. Mahany	14211US03	4061

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EXAMINER

TSE, YOUNG TOI

ART UNIT	PAPER NUMBER
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2611

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/684,747

Applicant(s)

MAHANY, RONALD L.

Examiner

YOUNG T. TSE

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20040123</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: in the amendment to the specification filed on August 16, 2004, the Applicant is requested to update the U.S. Application Nos., for example, the Application No. 08/513,658 is now U.S. Patent No. 6,714,983, and the Application Nos. 08/645,348, 08/544,815, and 08/457,697 are all abandoned. Appropriate correction is required.

Claim Objections

2. Claims 11-18, 21-24, 27-34 and 37-40 are objected to because of the following informalities:

In claim 11, lines 4-5 and 7, "to receive with a first type of modulation and a second type of modulation" and "and second type" should be "to receive with the first type of modulation and the second type of modulation" and "and the second type", respectively in order to avoid the antecedent basis that the select first type and second type of modulations are the transmit or receive modulations. Also see claims 21, 27, and 37.

In claim 13, line 2, the term "direct spread spectrum modulation" should be "direct sequence spread spectrum modulation". Also see claims 23, 29, and 39.

The dependent claims 12 and 14-18 are objected because they depend upon the independent claim 11.

The dependent claims 22 and 24 are objected because they depend upon claim 21.

The dependent claims 28 and 30-34 are objected because they depend upon the independent claim 27.

The dependent claims 38 and 40 are objected because they depend upon claim 37.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 17, 25, 33 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17, the "laptop computer" lacks connection or cooperation with any of the claimed subject matter of the precedent claim 11. Also see claims 25, 33, and 41.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 11-13 and 27-29 are rejected on the ground of nonstatutory double patenting over claims 1-2 of U. S. Patent No. 6,697,415 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: although the independent claims 11 and 27 of the instant application claim less claimed subject matter and use different wordings compared with the independent claim 1 of U. S. Patent No. 6,697,415, basically, the claimed subject matter recited in claims 11 and 27 of the instant application is included in claim 1 of U. S. Patent No. 6,697,415. Further, the claimed subject matter recited in each of the dependent claims 12 and 28 of the instant application is also included in the independent claim 1 of U. S. Patent No. 6,697,415. Wherein the claimed subject matter of each of the dependent claims 13 and 29 of the instant application is included in the dependent claim 2 of U. S. Patent No. 6,697,415.

For the reasons described above, although the conflicting claims 11 and 27 of the instant application are not identical to claim 1 of U. S. Patent No. 6,697,415, they are not patentably distinct from each other because the broader claims of the instant application would have been obvious in view of the narrow issued claim(s) of the U.S. Patent No. 6,697,415 (see *In re Emert*, 124 F.3d 1458, 44USPQ2d 1149).

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 11-15, 17-23, 25-31, 33-39 and 41-42 are rejected under 35 U.S.C. 102(a) as being anticipated by Smith et al. U.S. Patent No. 5,887,020 (hereinafter "Smith").

Regarding claims 11, 21, 27, and 37, Smith discloses a wireless radio transceiver in Fig. 1 comprising a dual band transmitter 1 and a dual band receiver 7 in communications with each other and with the hand held device 13. The detailed embodiments of the dual band transmitter 1 and the dual band receiver 7 are shown in

the block diagrams of Figures 2 and 3, respectively. Clearly, each of the transmitter 1 and the receiver 7 comprises a mode controller 103 and a mode select switch 104 for selecting either a first type of modulation (narrowband) or a second type of modulation (spread spectrum). See col. 6, lines 11-49; col. 7, line 1-22; and col. 8, lines 23-39 and 50-62.

Regarding claims 14-15, 19-20, 30-31, and 35-36, the transceiver is processing radio communications according to more than one mode and more than one frequency band, for example, a first protocol used for communications in a first frequency range (narrowband frequency band) and a second protocol used for communications in a second frequency range (spread spectrum frequency band). Wherein one of the frequency ranges includes 2.4 GHz within the range 2.4-2.4835 GHz. See the abstract.

Regarding claims 12-13, 22-23, 28-29, and 38-39, wherein one of the modulation types is a CDMA spread spectrum modulation, which clearly is a direct sequence spread spectrum modulation.

Regarding claims 17-18, 25-26, 33-34, and 41-42, as described in the description of related art (col. 1, lines 42-45), it is well known to a person skill in the art to provide a laptop or wireless communication or a desktop computer for wire communication with a communication transceiver or a hand held size as the hand held device 13 to be held in one hand of a user.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 16, 24, 32 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. as applied to claims 11, 21, 27, and 37 respectively, in view of Sheffer et al. U.S. Patent No. 5,131,019 (hereinafter "Sheffer").

Regarding claims 16, 24, 32 and 40 as applied to claims 11, 21, 27, and 37 respectively, although Smith does not include a modem transceiver arranged to provide wired communication wherein the controller 103 is arranged to select at least one of the radio transceiver and the modem transceiver.

Sheffer discloses a system in Figure 7 comprising a control interface circuit 60 for selecting one of a digital communicator (wired modem or transceiver) 5 and a cellular radio transceiver 3. See col. 4, lines 48-68.

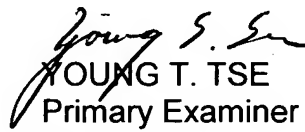
Therefore, it would have been obvious to one of ordinary skill in the art to include a wired modem or transceiver in Smith's radio communication system, for instance, within the PBX or PABX 14 in order to have both wireless and wire communications controlled by a controller or processor as taught by Sheffer that is capable of communication, for example, by a hand held device used in a remote area or a desktop computer used at office or home.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOUNG T. TSE whose telephone number is (571) 272-3051. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel can be reached on (571) 272-2988. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


YOUNG T. TSE
Primary Examiner
Art Unit 2611